

### REMARKS

The present application has been reviewed in light of the Office Action dated April 2, 2008. Claims 1, 4, and 25-30 are presented for examination, of which Claims 1, 25, 27, and 29 are in independent form. No claim changes are presented herein. Favorable reconsideration is requested.

The Office Action states that Claims 1, 4, and 25-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,057,893 (Kojima et al.) in view of U.S. Patent No. 5,774,624 (Enari). Applicant respectfully traverses the rejections and submits that independent Claims 1, 25, 27, and 29, together with the claims dependent therefrom, are patentably distinct from the cited references for at least the following reasons.

Claim 1 is directed to an image pickup apparatus that includes image pickup means, encoding means, recording means, transmission means, and control means. The encoding means functions to generate an encoded image signal by encoding a moving picture signal output from the image pickup means using an intraframe encoding method and an interframe encoding method. The encoded image signal includes therein a plurality of picture groups each constituted by an image signal of  $n$  frames ( $n$  being an integer equal to or larger than two), including intraframe-encoded pictures obtained through intraframe encoding processing and interframe-encoded pictures obtained through interframe encoding processing.

The recording means functions to record the encoded image signal on a recording medium, and the transmission means functions to transmit the encoded image signal to an external apparatus while maintaining an encoded state of the encoded image signal.

The control means functions to control the encoding means and the recording

means in accordance with an instruction to start a recording operation. The instruction to start recording is issued during transmission of the encoded image signal, and recording of the encoded image signal starts from a frame thereof corresponding to the instruction to start recording. When the instruction to start recording is issued, a number of intraframe-encoded pictures included in one picture group is changed without changing a number of frames included in one picture group, such that a number of intraframe-encoded pictures included in each picture group generated after issuance of the instruction to start recording is smaller than a number of intraframe-encoded pictures included in each picture group generated before the issuance of the instruction to start recording.

As discussed in the previous Amendments filed in the present application, a notable feature of Claim 1 is the control means, which effects control in accordance with an instruction to start a recording operation issued during transmission of the encoded image signal. In particular, control is effected such that all of the picture groups generated after the issuance of the instruction to start recording is controlled to have a smaller number of intraframe-encoded pictures relative to the number of intraframe-encoded pictures included in the picture groups generated before the issuance of the instruction to start recording.

Kojima et al. is directed to an encoding system whose purpose is to prevent picture quality from being degraded in the event of scene changes. (See, for example, column 2, lines 30-34, of Kojima et al., which states that “[i]t is therefore an object of the present invention to provide a picture encoding method and apparatus, a picture transmitting method and a picture recording medium wherein the picture quality of the predicted picture is not degraded in case of scene changes.”)

The Office Action alleges that Kojima et al. discloses all the features of Claim 1 except that, with respect to the claimed control means, Kojima et al. fails to disclose control means that controls encoding means and recording means in accordance with an issuance of a recording instruction. The Office Action then alleges that the disclosure missing from Kojima et al. is present in Enari.

In particular, it is alleged in the Office Action that one of ordinary skill in the art would extract from Enari the feature of changing encoding modes in accordance with an operation to start recording, and would use this feature to replace the feature in Kojima et al. of detecting a scene change and then changing a forward predictive-coded image directly after the detected scene change to an intra-frame coded image. The Office Action further contends that one of ordinary skill would “modify the event of scene change into an event of issuance of recording instruction” in order to “achieve a high compression ratio without degrading image quality.”

Applicant respectfully submits that the combination of Kojima et al. and Enari, as proposed in the Office Action, is improper. It is respectfully submitted that the proposed modification of the system disclosed in Kojima et al. with the teachings of Enari would render the Kojima et al. system unable to accomplish its intended goal. More specifically, as mentioned above, Kojima et al. is directed to an encoding system whose purpose is to prevent picture quality from being degraded in the event of *scene changes*. (See column 2, lines 30-34, of Kojima et al.) However, by modifying the Kojima et al. system to substitute a detection of a *scene change* to a detection of an *issuance of a recording instruction*, and then changing an encoding mode based on a detected issuance of a recording instruction instead of a detected scene change, the purpose

of the Kojima et al. system would be defeated. That is, the Kojima et al. system would not function in the intended manner of preventing picture quality from being degraded at *scene changes*, for at least the reason that scene changes would no longer be detected.

According to the MPEP at section 2143.01 and subsection V, a proposed modification cannot render the prior art unsatisfactory for its intended purpose, and cannot change the principle of operation of a prior-art reference.

If the proposed modification or combination of the prior art would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

MPEP 2143.01(V). Because it is believed that the modifications proposed in the Office Action would render the system of Kojima et al. unfit for its intended purpose, it is respectfully submitted that the rejection of Claim 1 is improper.

Additionally, Enari discloses a recording technique for intraframe-encoding all frames until an instruction to start recording is input (see, for example, column 3, lines 45-50), and thereafter intraframe-encoding a frame occurring immediately after the instruction to start recording and interframe prediction-encoding frames following the frame immediately after the instruction to start recording. Therefore, even if it would be permissible to combine Kojima et al. with Enari, such combination would merely result in the Kojima et al. system performing intraframe-encoding of all frames until an instruction to start recording is input, and thereafter intraframe-encoding a frame occurring immediately after the instruction to start recording and interframe prediction-encoding frames following the frame immediately after the instruction to start recording.

It is respectfully submitted that, absent the disclosure of the present application, one of ordinary skill in the relevant art would not find any teaching, suggestion, or motivation in the cited references to render it obvious to use control means for “controlling the encoding means and the recording means in accordance with an instruction to start a recording operation, issued during transmission of the encoded image signal by the transmission means, so as to start to record the encoded image signal from a frame thereof corresponding to the instruction to start the recording operation, and to change a number of intraframe-encoded pictures included in one picture group without changing a number of frames included in one picture group when the instruction to start the recording operation is issued, so that a number of intraframe-encoded pictures included in each picture group generated after issuance of the instruction to start the recording operation is smaller than a number of intraframe-encoded pictures included in each picture group generated before the issuance of the instruction to start the recording operation,” as claimed in Claim 1.

It is now well settled that a proper rejection under 35 U.S.C. § 103(a) cannot be based on the use of the claimed invention as a template from which to selectively pick and choose particular parts of a prior-art reference, while ignoring other parts of the prior-art reference. That is, the use of hindsight to reject a claim, the hindsight being developed after comprehending the disclosure of the claimed invention, is not permitted. In the present case, the rejection apparently is based on selectively picking only the feature of the issuance of the recording instruction from Enari, while ignoring the associated feature of intraframe-encoding of all frames until an instruction to start recording is input and thereafter intraframe-encoding a frame occurring immediately after the instruction to start recording and interframe

prediction-encoding frames following the frame immediately after the instruction to start recording, as discussed above. The Office Action does not establish why a person of ordinary skill in the art would find it obvious to try or use only the selected teachings of Enari and not the other teachings of Enari, or why the selective picking and choosing of pieces of the prior art would have yielded predictable results, or why there would be a reasonable expectation of success in the combination of selectively portions of the prior-art teachings. Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

In summary, Applicant submits that a combination of Kojima et al. and Enari, assuming such combination would even be permissible and proper, would fail to teach or suggest an image pickup apparatus that includes “control means for controlling the encoding means and the recording means in accordance with an instruction to start a recording operation, issued during transmission of the encoded image signal by the transmission means, so as to start to record the encoded image signal from a frame thereof corresponding to the instruction to start the recording operation, and to change a number of intraframe-encoded pictures included in one picture group without changing a number of frames included in one picture group when the instruction to start the recording operation is issued, so that a number of intraframe-encoded pictures included in each picture group generated after issuance of the instruction to start the recording operation is smaller than a number of intraframe-encoded pictures included in each picture group generated before the issuance of the instruction to start the recording operation,” as recited in Claim 1. Accordingly, Applicant submits that Claim 1 is patentable over the cited references and therefore respectfully request withdrawal of the rejection under 35 U.S.C.

§ 103(a).

Independent Claims 25, 27, and 29 include a similar control feature to that discussed above. Therefore, those claims are believed to be patentable for at least the reasons discussed above. The other rejected claims in the present application depend from one or another of the independent claims discussed above and therefore are submitted to be patentable for at least the same reasons. Because each dependent claim also is deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

This Response After Final Action is believed clearly to place the present application in condition for allowance. Therefore, entry of this Response under 37 C.F.R. § 1.116 is believed proper and is respectfully requested, as an earnest effort to advance prosecution and reduce the number of issues. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicant's undersigned attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

No petition to extend the time for response to the Office Action is deemed necessary for this Response. If, however, such a petition is required to make this Response timely filed, then this paper should be considered such a petition and the Commissioner is authorized to charge the requisite petition fee to Deposit Account 50-3939.

CONCLUSION

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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